

Application No. 10/709,646  
Technology Center 3711  
Amendment dated February 28, 2006  
Reply to Office Action of November 28, 2005

### REMARKS

In the Office Action, the Examiner reviewed claims 1-20 of the above-identified US Patent Application, with the result that the drawings were objected to and all of the claims were rejected. In response, Applicants have amended the specification, drawings, and claims as set forth above. More particularly:

The specification has been amended at paragraph [0009] to more accurately state that Figure 1 is a side view of a golf club (10).

The specification has been amended to insert a new paragraph describing new Figures 4 and 5 presented herewith.

The specification has been amended at paragraph [0013] to more accurately state that a suitable closure (30) is represented in phantom in Figure 2, not Figure 3.

Independent claim 1 has been amended to recite that the body of the device (20) is toroid-shaped, has an axis, and has a substantially uniform thickness in its axial direction (which finds support in original claim 8, Paragraph [0017], and Figures 1-3), the opening (22) in the body coincides with the axis of the body and the inner perimeter (24) of the body is concentric with the axis of the body (which finds support in Figures 1-3), the outer perimeter (26) is concentric with the axis of the body (which finds support in Figures 1-3), the outer perimeter (26) has a recess (32) defined therein that is sized and

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contoured to accommodate a portion of a hand gripping the second grip portion of the grip (12) (which finds support in original claim 5 and Figures 1-3), and aside from the recess (32) the outer perimeter (26) is substantially uniformly spaced radially outward from the inner perimeter (24) (which finds support in Figures 1-3).<sup>2</sup>

Similar to independent claim 1, independent claim 8 has been amended to recite that the opening (22) in the body coincides with the axis of the body and the inner perimeter (24) of the body is concentric with the axis of the body (which finds support in Figures 1-3), the outer perimeter (26) is concentric with the axis of the body (which finds support in Figures 1-3), the outer perimeter (26) has a recess (32) defined therein that is sized and contoured to accommodate a portion of a hand gripping the second grip portion of the grip (12) (which finds support in original claim 5 and Figures 1-3), and aside from the recess (32) the outer perimeter (26) is substantially uniformly spaced radially outward from the inner perimeter (24) (which finds support in Figures 1-3).

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<sup>2</sup> According to MPEP §2163 II.A.3(a), “drawings alone may provide a ‘written description’ of an invention as required by [35 USC §112, first paragraph],” and “[i]n those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.” (Citations omitted).

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Dependent claims 4, 5, 10, and 11 have been amended for consistency with their respective parent claims 1 and 8.

Independent claim 16 has been amended to omit the requirement for a slot (28) in the body, and to further require the step of grasping the grip (12) of the golf club (10) with the hands of the golfer so that the device (20) is a physical barrier between the hands and the first end of the shaft (18) to reduce the risk of the hands slipping off the grip (12) and off the first end of the shaft (18). Support for this amendment can be found in Applicants' specification at the last sentence of paragraph [0012].

Dependent claim 17 has been amended to reintroduce the limitation for the slot (28) that was canceled from its parent claim 16.

Dependent claim 20 has been amended to recite that the originally-recited "means for resisting torsional slip" is the result of the grip (12) of the golf club (10) being grasped with the hands so that portions of the hands and/or wrists are accommodated in a recess (32) defined on the outer perimeter (26) of the device (20). Support for this amendment can be found in Applicants' specification at the first two sentences of paragraph [0016].

Figure 3 has been revised to insert the inadvertently omitted reference letter "t."

New Figures 4 and 5 have been presented to provide two views

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showing the grip 12 of the golf club 10 of Figure 1 being gripped by a hand, which Applicants believe is consistent with the description at the last sentence of paragraph [0012] and at the first two sentences of paragraph [0016] of Applicants' specification, and original claims 4 and 5.

Applicants believe the above amendments do not present new matter. Favorable reconsideration and allowance of claims 1-20 are respectfully requested in view of the above amendments and the following remarks.

### **Objection to the Drawings**

The Examiner objected to the drawings under 37 CFR §1.84(p)(5) for lacking reference letter "t" found in the specification. With this response, Applicants are submitting corrected drawings that address this informality.

### **Rejection under 35 USC §102**

Independent claims 1, 8, and 16 and their respective dependent claims 2-5, 9-11, 14, and 17-20 rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,377,984 to Ciccia. Applicants respectfully request reconsideration of this rejection in view of the amendments presented above as well as the following comments.

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As noted in §2131 of the MPEP:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ...claim. The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e. identity of terminology is not required. (Citations omitted).

Applicants' amended independent claims 1 and 8 require a device (20) mountable or mounted on a generally conventional golf club (10) having a shaft (18) and a grip (12) at a first end of the shaft (18) opposite the club head. The grip (12) has a first grip portion and a second grip portion located closer to the second end of the shaft (18) than the first grip portion, with the grip (12) being tapered so that the second grip portion has a smaller diameter than the first grip portion. As an important aspect of the present invention, the device (20) can be mounted to the grip (12) and allow a golfer to grasp the second portion of the grip (12) below the device (20) in an entirely conventional manner.

Applicant's claimed device (20) comprises a body with an opening (22) having a minimum dimension larger than the diameter of the second grip portion of the grip (12) but smaller than the diameter of the first grip portion of the grip (12) so that the device (20) is prevented from being removed from the

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club (10) over the first grip portion. Applicants' claimed device (20) further requires the following:

the opening (22) in the body coincides with the axis of the body and defines an inner perimeter (24) of the body concentric with the axis of the body; an outer perimeter (26) that is concentric with the axis of the body and is spaced radially outward from and surrounds the inner perimeter (24); and aside from a recess (32) defined in the outer perimeter (26), the outer perimeter (26) is substantially uniformly spaced radially outward from the inner perimeter (24).

In addition to the above limitations, independent claim 1 further requires the body is toroid-shaped and has a substantially uniform thickness (*t*) in its axial direction, and independent claim 8 further requires that the body has an axis of symmetry.

In contrast, Ciccia discloses a universal grip 1 that does not meet any of the above limitations as a result of its body having a nonuniform thickness, an outer perimeter 6-9 that is not concentric with the axis of the body and is not uniformly spaced radially outward from an inner perimeter of the body formed by an opening 5 in the body, a body that is not toroid-shaped, and a body that lacks an axis of symmetry.

In view of the above, Applicants believe that Ciccia does not anticipate

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independent claims 1 or 8 nor any of their dependent claims under the test for anticipation set forth at MPEP §2131.

Applicants' amended independent claim 16 recites a method of using a device (20) similar to that recited in independent claims 1 and 8, and requires the step of grasping the grip (12) of the golf club (10) with the hands so that the device (20) is a physical barrier between the hands on the grip (12) and the first end of the shaft (18) to reduce the risk of the hands slipping off the grip (12) and off the first end of the shaft (18).

In contrast, Ciccia does not disclose or suggest a method by which a golfer grips the handle 2 of the golf club below the grip 1. Instead, Ciccia discloses that the golfer grasps the grip 1 itself, as shown in Figure 5. In view of the above, Applicants believe that Ciccia does not anticipate independent claim 16 nor any of its dependent claims under the test for anticipation set forth at MPEP §2131.

In view of the above, Applicants respectfully request withdrawal of the rejection under 35 USC §102.

### **Rejections under 35 USC §103**

Dependent claims 6, 7, 12, and 13 were rejected under 35 USC §103(a) as being unpatentable over Ciccia, and dependent claim 15 was

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rejected as being unpatentable over Ciccia in view of U.S. Patent No. 6,482,113 to Finn. Applicants respectfully request reconsideration of these rejections in view of the claims as amended and the following comments.

In regard to claims 6 and 12, the Examiner concluded that it would have been obvious to one of ordinary skill in the art to provide a high-friction coating on Ciccia's grip to ensure the user maintains a proper contact throughout the swing. In regard to claims 7 and 13, the Examiner concluded that it would have been obvious to one of ordinary skill in the art to vary the weight of Ciccia's grip. However, as discussed above, nothing in Ciccia teaches or suggests the limitations now recited in independent claims 1 and 8, from which claims 6, 7, 12, and 13 depend. Therefore, Applicants believe that Ciccia does not teach or suggest Applicants' golf training device recited in claims 6, 7, 12, and 13, and even teaches away from the claimed invention to the extent that Ciccia *requires* a device with an exterior that can be gripped by a golfer, which is contrary to Applicants' teachings and claims for a device (20) that is "essentially imperceptible" to a golfer. Paragraph [0015]. Therefore, Applicants respectfully request withdrawal of the first rejection of the claims under 35 USC §103.

In view of the above, Applicants believe that Finn cannot be said to supplement the teachings of Ciccia in order to arrive at Applicants' invention

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recited in dependent claim 15, which depends from independent claim 8. Finn was applied by the Examiner for disclosing a closing strap for a gripping device to ensure the grip stays on the handle, and not for anything that would suggest modifying Ciccia's device to yield a device as taught and claimed by Applicants. Therefore, Applicants also respectfully request withdrawal of the second rejection under 35 USC §103(a).

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**Closing**

In view of the above, Applicants believe that all issues outstanding from the Office Action have been addressed, and that the claims define patentable novelty over all the references, alone or in combination, of record. It is therefore respectfully requested that this patent application be given favorable reconsideration.

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

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Attachments: Replacement Drawing Sheets (2)